

REMARKS

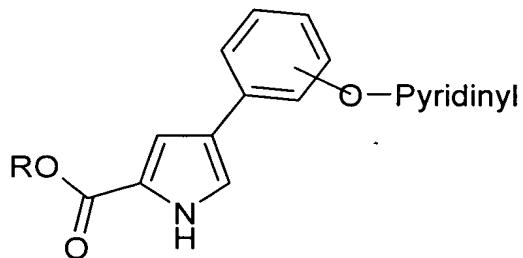
Amendments

Claims 1-11, 15-21, and 28-34 are cancelled. Claim 12 is amended to be in independent form. Claims 13, 14, and 22-25 are amended to depend from claim 12. New claims 35-53 are directed to compounds of claim 12, and all depend from claim 12. Thus, all of the pending claims depend from claim 12 except claims 26 and 27.

In addition, claim 12 is amended to correct obvious typographical errors. Several of the named compounds had the term “methylmethyl”, for example, *N*-methyl-4-{4-[5-(4-chloro-3-trifluoromethylmethylphenylcarbamoyl)-1*H*-pyrrol-3-yl]phenoxy}pyridine-2-carboxamide.

It is readily apparent that “methyl” was inadvertently included twice. See, e.g., Example 1 which begins at page 50 of the specification. The title of this example refers to the preparation of *N*-methyl-4-{4-[5-(4-chloro-3-trifluoromethylmethylphenylcarbamoyl)-1*H*-pyrrol-3-yl]phenoxy}pyridine-2-carboxamide, i.e., compound (6). As can be seen, this compound name has the error regarding the two methyls. The structure of compound (6) is shown at page 54, and has a trifluoromethyl attached to the 3-position of the phenyl group on the left hand side of the structure. Also, the compound used in the synthesis of compound (6) to make the phenyl group on the left hand side of the structure is 5-amino-2-chlorobenzotrifluoride.

Claim 26 is amended to recite that Ar is pyridinyl and X is –O-. Thus, the compounds of claim 26 and claim 12 have a significant common core structure, i.e.:



Restriction

With respect to the withdrawn method of treatment claims 22-25, applicants request

rejoinder pursuant to MPEP 821.04.

In addition, applicants again request reconsideration of the Restriction Requirement with respect to claims 26 and 27. As noted above, the compounds of claims 12 and 26 share a significant common core structure. In light of this prominent common structure, there is no significant burden in examining all of the compounds together. Withdrawal of the Restriction between Groups I and II is respectfully requested.

Rejection under 35 USC 112, first paragraph

Claims 1-14 and 28-34 are rejected as allegedly being indefinite. This rejection is respectfully traversed.

While applicants do not agree with the arguments that “solvates” are non-enabled, in order to further prosecution claim 12 is amended to delete the reference to solvates. Withdrawal of the rejection is respectfully requested.

Rejection under 35 USC 103(a) in view of Sun et al.

Claims 1-14 and 28-34 are rejected as allegedly being obvious in view of Sun et al. US 2004/0138269. This rejection is respectfully traversed.

In the rejection, there is no explanation as to how the disclosure of Sun et al. renders obvious the specific compounds recited in claim 12. Sun et al. disclose a broad genus defined by Formula I, and two broad subgenera defined by Formulas II and III. See paragraphs [0020]-0048]. In terms of specific compounds, see the compounds described at paragraphs [0049]-0105], and in the Examples.

The mere disclosure of a broad genus does not render obvious each and every embodiment encompassed therein. See, for example, the non-precedential opinion issued by the Board in *Ex parte Rozzi*, 63 USPQ2d 1196, 1201 (Bd. of Pat. Appls. & Interf. 2002), where the Board, in reversing an obviousness rejection stated:

The Examiner does not make out a case of obviousness merely by virtue of the fact that the subject matter of a rejected claim is, to use the examiner’s words, ‘generically’ described by the prior art.

When it comes to the teaching of a broad genus of species and what is fairly rendered obvious by such a disclosure, the law is well established by such Federal Circuit decisions as

In re Jones, 21 USPQ2d 1941, 1943, (Fed. Cir. 1992) and *In re Baird*, 29 USPQ2d 1550 (Fed. Cir. 1994). When analyzing whether disclosure of a broad genus of species will render obvious certain species thereof, one must look to the specific species described by the prior art reference to determine if they suggest the claimed subject matter.

See, for example, the Court's decision in *In re Baird* wherein the Court noted that a prior art genus of diphenol compounds for use in developer compositions encompassed bisphenol A, which was used as part of a claimed toner composition. However, the Court held that this generic disclosure did not render obvious the particular claimed embodiment, after comparing the structure of bisphenol A with the structures of the specifically disclosed diphenols in the prior art reference.

See also, e.g., *In re Jones*, 21 USPQ2d 1941, 1943, (Fed. Cir. 1992) wherein the Court in reversing the Board's decision of *prima facie* obviousness, disputed the Board's reliance on the Court's prior decision, *Merck & Co. v. Biocraft Labs, Inc.*, 10 USPQ2d (Fed. Cir. 1989):

We decline to extract from *Merck* the rule that the Solicitor appears to suggest -- that regardless of how broad, a disclosure of a chemical genus renders obvious any species that happens to fall within it. In contrast, though Richter [the prior art relied on] discloses the potentially infinite genus of 'substituted ammonium salts' of dicamba, and lists several such salts, the claimed salt here is not specifically disclosed. Nor, as we have explained above, is the claimed salt sufficiently similar in structure to those specifically disclosed in Richter as to render it *prima facie* obvious (emphasis added).

Thus, the analysis used by the Court in *Jones* to determine whether obviousness was established by the prior art was to compare the claimed salt with those salts specifically disclosed by the prior art reference.

Turning to the specific compounds disclosed by Sun et al., it is noted that none of the compounds exhibit a B group, according to formulas I and II of Sun et al., that is a pyridinyl group. Instead, in all of these compounds B is phenyl (as in Sun et al.'s Formula III). Compare applicants' compounds recited in claim 12 and the definition of Ar recited in applicants' claims 13 and 26. Also, in all of the specific compounds disclosed by Sun et al. the group L, according to formulas I-III of Sun et al., is always -CO-NH-, -CO-NH-CH₂-, -NH-CO-, or -NH-CO-NH-. Compare applicants' compounds recited in claim 12 and the

definition of X recited in applicants' claims 13 and 26. .

In view of the above remarks, it is respectfully requested that the disclosure of Sun et al. fails to suggest the compounds of applicants' claims. Nothing within the disclosure of Sun et al. would lead one of ordinary skill in the art to select a compound in accordance with applicants' claimed invention. Withdrawal of the rejection is respectfully requested.

Rejection under 35 USC 103(a) in view of Bannen et al.

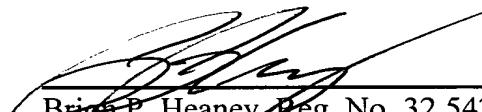
Claims 1-14 and 28-34 are rejected as allegedly being obvious in view of Sun et al. US 2008/0234270. This rejection is respectfully traversed.

This rejection is not applied against claim 12. As noted above, claims 1-11 and 28-34 are cancelled, and claims 13-14 are amended to depend from claim 12. Thus, withdrawal of the rejection is respectfully requested.

In addition, filed herewith is a certified English translation of applicants' German priority application, DE 103 54 060.1, filed November 19, 2003.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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